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EXAMINER

BRIER, J

21

ART UNIT

PAPER NUMBER

2415

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OCT 9 - 1997

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/300,500

Filing Date: 9/2/94

Appellant(s): Banerjee et al

mailed
OCT 9 - 1997

Edward C. Kwok

For Appellant

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed 7/21/97.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed. A request for reconsideration was received on 2/21/97, the Scientific American article was faxed to applicant on 3/7/97, a telephone interview was held on 3/10/97 and 3/11/97, and an Advisory action was mailed on 3/21/97. Copies of the interview summary paper no. 13 and the Advisory action paper no. 16 are enclosed with this examiner's answer.

(5) *Summary of Invention*

The summary of invention contained in the brief is substantially correct. Page 4 lines 5 and 6 is incorrect because appellants system does not have a graphical tem but instead it has a graphical subsystem.

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(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3 and 6-11 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1-13 appears on pages 18-22 of the Appendix to the appellant's brief. The minor errors are as follows:

claim 2 line 12 "tem" should be "subsystem"; and

claim 6 line 8 "wiresless" should be "wireless" since it was changed in an examiner's amendment (paper no. 6) and appellant did not disagree with this change.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,309,351	McCain et al	5/3/94
"The Computer for the 21st Century" by Mark Weiser, Scientific American, September 1991 pages 94-104.		

(10) *New Prior Art*

No new prior art has been applied in this examiner's answer.

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(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The text of the final rejection is reproduced below and the text of the rejection of claims 4 and 12 is slightly amended.

Claims 1 and 6-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by McCain et al U.S. Patent No. 5,309,351. This reference with an effective filing date of October 27, 1988 describes a portable touch screen display which uses an infrared link as a connection to a host computer which performs application processing and provides display information to the portable touch screen display via the infrared link. Especially note column 7 lines 30-33 and lines 58-60 and column 9 lines 46-47 and column 10 lines 41-46 which describes a portable unit constructed of a minimum of parts with limited processing capability. Also note In re Graves, 36 USPQ2d 1697, 1701 (CAFC December 4, 1995) which teaches that fundamental technical information known to one of ordinary skill in the art need not be explicitly taught by the reference for the reference to show that the claimed invention is old under 35 U.S.C. § 102.

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Re claim 1:

The stylus of this claim is covered by the operator's finger in the McCain system. In McCain any stylus capable of giving an indication of touch to the touch screen may be considered a stylus.

Claim Rejections - 35 USC § 103

Claims 4 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over McCain et al U.S. Patent No. 5,309,351 and More et al U.S. Patent No. 5,194,852. McCain fails to teach recognition of handwriting entered at the portable touch screen display (claims 4 and 12) and especially does not teach performing the hand recognition analysis at the host computer. McCain does teach a graphics capability in the display at column 8 line 67 to column 9 line 24 which suggests that a graphics input would be desirable in addition to the menu selection described at column 9 lines 25-27. A graphics display suggests this because it is desirable to have the input resolution equal to the output resolution so it will be possible to have the input and output data correspond to the same pixel location. More describes handwriting detection in a portable computer. It would have been obvious to one of ordinary skill in the art to incorporate handwriting recognition into the host computer of McCain so detailed user input may be detected by the system.

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Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over McCain et al U.S. Patent No. 5,309,351 and in view of Kannan et al U.S. Patent No. 5,423,045. McCain fails to teach power conservation (claims 5 and 13) in the portable touch screen display. Column 8 lines 43-51 describes the power supply used in McCains' portable touch screen display, but, does not describe a power management circuit for suspending operation of the portable touch screen display under certain conditions. This, however, is taught to be old by Kannan et al. as a means to prolong the life of the battery. For this reason it would have been obvious to one of ordinary skill in the art to incorporate into the portable touch screen display of McCain a power management routine for suspending operation of the portable touch screen display under certain conditions to prolong the life of the battery.

Allowable Subject Matter

Claims 2, 3, and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(12) New Ground of Rejection

This examiner's answer does not contain any new ground of rejection.

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(13) Response to argument

At page 9 first full paragraph appellants state that appellants did not have access to the Scientific American article because it was not officially cited on a PTO-892, however, this article was faxed to Edward Kwok on 3/7/97. Mr. Kwok's silence about the further status of the Scientific American article between the date the article was faxed by the Patent Office and the date this Appeal was filed is an indication that appellant has possession of that article and the fact that the Patent Office failed to officially list that document on a PTO-892 does not prove that appellant did not have benefit of having that article prior to filing the Appeal Brief. This article is now officially cited on a PTO-892 which is enclosed with this examiner's answer.

The arguments concerning McCain have been reviewed. The argument concerning claim 1 starting at page 10 of the brief has been noted. The rejection of this claim is maintained because the arguments at page 11 of the brief are not supported by McCain. Unarguably the portion of McCain relied upon by the examiner is under the heading of (8) Interactive operation between hand-held unit and host. However this heading does not limit the teaching at column 7 lines 30-33 to that which is alleged by appellant. Here the portable touch screen display is described as maintaining the menu driven interface when the host computer runs programs too large for the portable touch screen display to handle. In this mode of operation the display provides responses to the user in response to "positional data representative of a current location of the position input device". This is the typical response that a menu based program provides to

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the user. An example of visual responses to positional device locations is present in windowing programs. Such programs were in existence prior to the time of applicants invention. Responses to positional device locations is described in the previously cited Scientific American article ("The Computer for the 21st Century"). The portable touch screen display would also send the positional data over the wireless link to the host computer to be used by the program running on the host computer. The wireless transmission of the positional data is the type of fundamental technical information that one of ordinary skill in the art the time of applicants invention would know is necessary for the host computer and the portable touch screen display to perform their programed functions. Furthermore one of ordinary skill in the art would know how to accomplish the transmission of the positional data from basic communication technology. A reference to show such a transmission is not necessary and is inherent to the reference itself. The transmission of data necessary to perform programed functions is described in the previously cited Scientific American article. Thus, McCain teaches the framework of applicants invention and the previous knowledge of one of ordinary skill in the art provides the foundation and explains the inherent functions performed by McCain.

The argument concerning claims 6 and 11 at page 13 of the brief has been noted. The rejection of this claim is maintained because when the portable touch screen display sends the positional data over the wireless link to the host computer to be used by the program running on the host computer, a wireless receiver/transceiver at the host computer would receive the positional data. The wireless reception of the positional data by the host computer is the type of

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fundamental technical information that one of ordinary skill in the art at the time of applicants invention would know is necessary for the host computer and the portable touch screen display to perform their programmed functions. Furthermore one of ordinary skill in the art would know how to accomplish the wireless reception of the positional data from basic communication technology. A reference to show such a reception is not necessary and is inherent to the reference itself. The reception of data necessary to perform programmed functions is described in the previously cited Scientific American article.

The argument concerning claim 2 is persuasive since McCain does not teach or suggest a system controller unit coupled to the processor bus for controlling the input subsystem, the graphical subsystem, and the wireless communication system. McCain further does not teach or suggest a peripheral bus coupled to the wireless communication system.

The argument concerning claims 8 and 10 have been considered but McCain inherently has buffers for queuing the points detected by the input device.

The arguments concerning More et al and McCain have been reviewed, however, the combined teachings of More and McCain renders claims 4 and 12 obvious.

The arguments concerning Kannan et al and McCain have been reviewed, however, the combined teachings of Kannan and McCain renders claims 5 and 13 obvious .


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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


JEFFERY BRIER
PRIMARY EXAMINER
GROUP 2600

10/06/97

enclosed: PTO-892

Interview summary paper no. 13

Advisory action paper no. 16